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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,797	05/01/2001	James J. Hogan	GP121-02.UT	5168
21365	7590	08/12/2003		
GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE SAN DIEGO, CA 92121			EXAMINER KATCHEVES, KONSTANTINA T	
			ART UNIT 1636	PAPER NUMBER 12

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/846,797	HOGAN ET AL.
	Examiner Konstantina Katcheves	Art Unit 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 July 2003, 01 October 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13,15-37 is/are pending in the application.

4a) Of the above claim(s) 26-36 is/are withdrawn from consideration.

5) Claim(s) 13,17,19 and 21-25 is/are allowed.

6) Claim(s) 37 is/are rejected.

7) Claim(s) 15, 16, 18, 20 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 4

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 13 and 15-37 are pending in the present application. This Office action is in response to the amendment filed 7 November 2002 and the election filed 18 July 2003.

#### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 13-25 and new claim 37 and SEQ ID Nos:1, 4 and 5 in Paper No. 6 and Paper No. 11 is acknowledged. Applicant argues that it would not present a serious search burden to examine SEQ ID Nos:1 and 5 together because SEQ ID NO:1 differs from SEQ ID NO:5 in that it is only a single nucleotide longer. Thus, a search for both would not be unduly burdensome. This is found persuasive and SEQ ID NO:1 and 5 have been examined. Applicant has also argued that claims 26-36 should be rejoined with Group I as a process of using the product of Group I. This argument is found persuasive. Should Group I be found allowable, Group II will be rejoined. Applicant elected helper sequence, SEQ ID NO:6 without traverse in Paper No. 11.

Insofar as applicable given the discussion above, the requirement is still deemed proper and is therefore made FINAL.

#### ***Claim Objections***

Claims 15, 16, 18 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Independent claim 13 recites an oligo probe having

the length and sequence of SEQ ID Nos: 1 or 5. Dependent claim 15 recites that the oligo probe comprises DNA which does not limit claim 13 since SEQ ID Nos: 1 and 5 comprise DNA probes. Dependent claim 16 does not further limit claim 13 because it recites a probe that consists of SEQ ID Nos:1 or 5. Generally, the language “consists of” would be considered narrower than open language such as “comprising” or “having.” However, claim 13 recites the limitation that the oligo probe comprises the length and sequence of SEQ ID Nos:1 or 5. This limitation effectively renders claim 16 and the claims such as 18, 19 and 20 that depend therefrom duplicative of claim 13 and its dependent claim 17 and 19. At a minimum, the duplicative claims must be cancelled upon allowance of independent claim 13.

Claims 25 and 35 are objected to because they are drawn to non-elected subject matter. Pursuant to the restriction requirement in the present application, Applicant elected SEQ ID NO:4 as a helper probe in Paper No.11, filed 18 July 2003. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites a sequence that “confers a secondary structure” and a sequence that “confers a tertiary structure.” This language raises several questions. To what is a secondary or tertiary structure conferred or given? Is Applicant referring to the structure of the oligo probe or

is Applicant referring to the structure of some other molecule? Is Applicant referring to the structure of a nucleic acid sequence or amino acid sequence? Because the claims raise such questions, the claim is therefore vague and indefinite.

***Allowable Subject Matter***

Claims 13, 14, 17, 19 and 21-25 are found allowable.

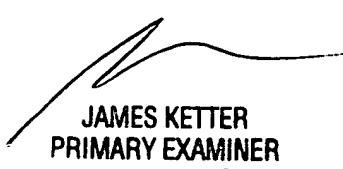
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves  
August 8, 2003

  
JAMES KETTER  
PRIMARY EXAMINER